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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 09/719,559 | 03/02/2001 | Reinhard Plaschka | JEK/PILASCHKA | 3460 |
| 7590 | | 06/29/2006 | EXAMINER | |
| Bacon & Thomas | | FERGUSON, LAWRENCE D | | |
| 4th Floor | | ART UNIT | | |
| 625 Slaters Lane | | PAPER NUMBER | | |
| Alexandria, VA 23124-1176 | | 1774 | | |

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 09/719,559 | Applicant(s) PLASCHKA ET AL. | |
| | Examiner Lawrence D. Ferguson | Art Unit 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-34 is/are allowed.
- 6) ☒ Claim(s) 18, 19 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed April 12, 2006.
Claims 18 and 29-30 were amended and claim 46 was cancelled rendering claims 18-19 and 21-34 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-19, 21-23, 25, 27-29 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418).

Chiang discloses an ID card having a security pattern (column 4, lines 15-35) with a paper support that can be plastic (column 4, lines 45-62) having a polymeric security layer comprising adhesives having acrylate material (column 5, lines 5-15 and column 6, lines 7-15) which protects the paper layer. Chiang further discloses the visible colored pattern or design can be fluorescent pigment that becomes visible when examined under ultra violet light or machine-readable pattern (column 8, lines 1-10). The printed

Art Unit: 1774

indicia can be applied onto the polymeric layer using printing ink (column 6, lines 57-62). Chiang discloses laminating the image surface of the print with a plastic overlay (column 5, lines 18-25) which is interpreted as an outer lacquer layer. Chiang does not explicitly disclose a coating weight as in instant claim 19. However, such coating weight is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the coating weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. coating weight) fails to render claims patentable in the absence of unexpected results. The coating weight is optimizable as it directly affects the durability and flexibility of the security paper. It would have been obvious to one of ordinary skill in the art to make the security paper with the limitations of the coating weight since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Chiang does not explicitly disclose the coating is dirt repellant.

Mueller teaches a paper with a dirt repellent protective coating disposed on the surface of the paper layer (column 5, line 57 through column 6, line 25). It would have been obvious to one of ordinary skill in the art to have employed the dirt repellent protective layer, as taught in Mueller, on the paper substrate of Chiang to reduce frictional resistance without affecting the surface of the paper (column 6, lines 26-41) and extending the life and usability of the paper.

Claim Rejections – 35 USC § 103(a)

4. Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Manser et al. (U.S. 5,525,400).

Chiang and Mueller are relied upon for instant claim 18 as above. Chiang does not disclose the paper being unsized. Manser teaches an ID card (column 1, lines 5-10) where the paper is sized or unsized and may contain various fibers (column 3, lines 8-10) where the adhesive portion comprises acrylates or methacrylates (column 4, lines 5-19). Chiang and Manser are both directed to ID cards having acrylate adhesive material. It would have been obvious to one of ordinary skill in the art for the paper of Chiang to be unsized so the security paper can be used in a variety of shaped ID cards for more versatility and utility.

Claim Rejections – 35 USC § 103(a)

5. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Takeuchi et al. (U.S. 4,856,857).

Chiang and Mueller are relied upon for instant claim 18 as above. Chiang does not disclose the paper having cotton fibers. Takeuchi teaches an ID card having an adhesive layer comprising polymethacrylic material (column 14, lines 9-24) having a

Art Unit: 1774

paper support comprising cotton fiber (column 19, lines 11-35). Chiang and Takeuchi are both directed to ID cards having acrylate adhesive layers. It would have been obvious to one of ordinary skill in the art to include cotton fiber in the substrate of Chiang to improve the texture of the ID card.

6. Claims 30-34 are allowed. The closest prior art does not teach or suggest the recited document of value further including a method for producing a security paper, applying a dirt repellent coating to at least a part of one of the surfaces of the paper layer, wherein said coating consists of a composition containing only an acrylate binder and lacking a filler substance.

Response to Arguments

7. Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) has been considered but is unpersuasive. Applicant argues layer 14 of Chiang is not a security layer but is clearly an adhesive layer. Examiner respectfully disagrees because Chiang discloses layer 14 is a polymeric security layer which is capable of being adhered with an image receiving layer, but which also can accept printing ink directly on its surface. Consequently, Examiner maintains that it would have been obvious to one of ordinary skill in the art to have employed the dirt repellent protective layer, as taught in Mueller, on the paper substrate of Chiang to reduce frictional resistance without

Art Unit: 1774

affecting the surface of the paper (column 6, lines 26-41) and extending the life and usability of the paper.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Manser et al. (U.S. 5,525,400) has been considered but is unpersuasive. Applicant argues because Manser fails to make up for the shortcomings of Chiang and Mueller it should be withdrawn. Because Chiang and Mueller have been maintained, the rejection made under 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Manser et al. (U.S. 5,525,400) is also maintained for reasons of record.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Takeuchi et al. (U.S. 4,856,857) has been considered but is unpersuasive. Applicant argues because Takeuchi fails to make up for the shortcomings of Chiang and Mueller it should be withdrawn. Because Chiang and Mueller have been maintained, the rejection made under 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Takeuchi et al. (U.S. 4,856,857) is also maintained for reasons of record.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Kaule (U.S. 5,817,205) in view of Chiang et al. (U.S. 5,380,695) has been considered and the rejection is withdrawn due to Kaule comprising filler material in its coating layer.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

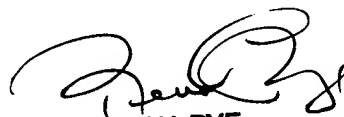
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 6/23/06